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| TRANSMITTAL | | Application Number | | 10/014,318 |
| | | Filing Date | | November 9, 2001 |
| FORM | | First Named Inventor | | Pallavicini, Maria G. |
| (to be used for all correspondence after initial filing) | | Art Unit | | 1639 |
| | | Examiner Name | | Teresa D. Wessendorf |
| Total Number of Pages in This | | Attorn | ey Docket Number | 02307O-120900US |
| Submission | | | | |
| ENCLOSURES (Check all that apply) | | | | |
| Fee Transmittal Form | ☐ Drawing(s) | | | After Allowance Communication to Group |
| Fee Attached | Licensing-related Papers | | ed Papers | Appeal Communication to Board of Appeals and Interferences |
| Amendment/Reply-"Response to Restriction Requirement" | | ı | | Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| After Final | Petition Provision | | vert to a blication | Proprietary Information |
| Affidavits/declaration(s) | Power of Attorney, Revocation Change of Correspondence Address | | | ☐ Status Letter |
| Extension of Time Request | | Terminal Disclaimer | | Other Enclosure(s) (please identify below): |
| Express Abandonment Request | Request for Refund CD, Number of CD(s) | | | Return Postcard |
| Information Disclosure Statement | | 05, Number of 05(0) | | |
| Certified Copy of Priority Document(s) Remar | | The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430. | | |
| Response to Missing Parts/ Incomplete Application | | | | RECEIVE OCT 1 6 2003 |
| Response to Missing Parts under 37 CFR 1.52 or 1.53 | | | | OCT 1 6 2003 |
| | | | 101111 177071 | TECH CENTED 4000 |
| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | | |
| Firm Townsend and Townsend and Crew LLP or Individual Jean M. Lockyer, Ph.D. Reg. No. 44,879 | | | | |
| Individual Jean W. Lockyer, Fri.D. Reg. No. 44,879 | | | | |
| Signature | | | | |
| Date October 10, 2003 | | | | |
| CERTIFICATE OF TRANSMISSION/MAILING | | | | |
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. | | | | |
| Typed or printed name Malinda C. Dagit | | | | |
| Signature Malinda Choqif Date 10 Oct. 2003 | | | | |

OCT 1 4 2003 I hereby certify the this correspondence is being deposited with the United States Postal Service as mail in an envelope addressed to:

Attorney Docket No.: 02307O-120900US

Client Ref. No.: 1997-115-1

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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10: 1997-1
16CH CENTER 162003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

PALLAVICINI and MULLANEY

Application No.: 10/014,318

Filed: November 9, 2001

For: IDENTIFICATION OF

EXPRESSED GENES USING PHAGE

DISPLAY

Customer No.: 20350

Confirmation No.: 1486

Examiner:

Teresa D. Wessendorf

Technology Center/Art Unit: 1639

RESPONSE TO RESTRICTION

REQUIREMENT

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 10, 2003, Applicants elect Group I, claims 1-16, drawn to a method of identifying an exon in a eukaryotic genomic fragment. In addition, Applicants elect the following species from the subgroups set forth by the Examiner. Subgroup D is not included, as the designated claims are not in Group I.

Subgroup A: Applicants elect a binding partner that is an antibody. The claims of Group I that read on the elected species are claims 1-16.

Subgroup B: Applicants elect a stimulated B-cell library. The claims of Group I that read on the elected species are claims 1-16.

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Subgroup C: Applicants elect a protein epitope encoded by the genomic sequence. The claims of Group I that read on the elected species are claims 1-16.

The species election is made with the understanding that upon the determination that the elected species is free of the prior art, additional species will be examined in accordance with MPEP § 803.02, which states that "should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." and that "[t]he prior art search will be extended to the extent necessary to determine the patentability of the Markush-type claim."

The foregoing restriction and species elections are made with traverse. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. *See*, the MPEP at 803.01. In establishing that an "undue burden" would exist for coexamination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. Applicants respectfully submit that examination of the claims in Groups I-IV would not create an undue burden and respectfully request withdrawal of the restriction and species election requirements in this case.

PATENT

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

Jean M. Lockyer, Ph.D. Reg. No. 44,879

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